



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,301	11/28/2001	Takao Yoshimine	275759US6PCT	1118
22850 7590 10/09/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GARG, YOGESH C	
			ART UNIT 3625	PAPER NUMBER
			NOTIFICATION DATE 10/09/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

09/980,301

Applicant(s)

YOSHIMINE ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,13-16,24,25 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,13-16,24-25,30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's Amendment received on 8/1/2007 is acknowledged and entered. Claims 1,5,13,31,32 and 33 are amended. Claims 9-12, 17-23, 26-29 were previously canceled. Currently claims 1-8, 13-16, 24-25 and 30-33 are pending for examination.

Response to Arguments

2.1. In view of the amendments made to claims 1, 32 and 33, rejection of claims 31-32 under 35 USC 112, first paragraph, rejection of claim 32 under 35 USC 112, second paragraph and Objection to Specification are withdrawn.

2.2. Applicant's arguments (see Remarks/Arguments on pages 11-13) filed 8/1/2007 with regards to prior art rejection of claim 1 have been considered but are not persuasive. The applicant argues that Miller does not teach the " receipt over a network of personal content data which were personally created by a content provider". In response, the examiner would like to point out that this limitation, that is the type of data [personal content produced by a content provider] the claimed device in claim 1 receives is an intended use and therefore cannot be considered for patentability. The prior art structure, that is the apparatus in Miller is capable of receiving personal content data created by a content provider over a network and therefore it meets the currently amended claim1. In Miller, see paragraph 033 which suggests that a donor can make a

Art Unit: 3625

contribution for a special project which could refer to a personal content data personally created by a content provider and received over a network at the website 11 and stored in database 14 from where can be retrieved by clicking the button "view", see Figs 3A, 3B and 10.

Applicant argues that Miller does not display both of the personal content and the contribution icon, simultaneously. The examiner respectfully disagrees because Miller does suggest, see Figs 3A, 3B and 10 wherein a donor can view the icon representative of the content and the contribution icon simultaneously and by clicking on "view" can see the description.

Applicant further argues that teachings of Hartman of a registered user cannot be combined because it teaches away from his invention as it does not teach the other limitations of claim 1. The examiner disagrees because the applicant is attempting to attack the Hartman reference individually by stating that it does not teach the other recited features of claim 1. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, Miller, as analyzed above and earlier in the Final office action mailed on 5/2/2007 teaches all the limitations of currently amended claim 1 except that the donors are registered. In order to overcome this deficiency, the examiner combined the teachings of Hartman because by registering the donors the system does not have to collect information about making payments.

Art Unit: 3625

In view of above, the rejection of claim 1 is sustainable as being unpatentable under 35 USC 103 (a) over Miller/Hartman.

3.3. Regarding claim 31, in response to the applicant's request for providing an evidence for making payments using electronic money the same was already cited in the previous office action. US Patent 6,029,151 to Nikander (see at least Abstract and col.2, lines 46-54) teaches using electronic money to make payments for online transactions. The applicant argues that Nikander (US Pat. 6,029,151) teaches the use of electronic money to make payments for telephone bill and therefore it teaches away from his claimed invention. The examiner respectfully disagrees because the mere reason that electronic money in Nikander is used for paying telephone bills it cannot be used for payment for other uses such as making donations or making online purchases. If this reasoning is good then if the credit/debit cards being used for donation cannot be used for making payments for telephone bills/online purchases and this is not true.

In view of above, the rejection of claim 31 is sustainable as being unpatentable under 35 USC 103 (a) over Miller/Hartman/Official Notice.

This is a Final Office action.

4. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

Art Unit: 3625

limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3625

5.1. Claims 1, 3-4, 5, 7-8, 13, 15-16, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (US Publication 2001/0051875 A1), hereinafter Miller and further in view of Hartman et al. (US Patent 5,960,411), hereinafter Hartman.

Regarding claim 1, Miller teaches a contribution processing device (see Figs. 1-16), comprising:

receiving unit configured to receive over a network from a predetermined server personal content data which were personally created by a content provider and display data for displaying user contribution icon including a contribution button configured to select to indicate that a contribution is to be given to the content provider of the personal content data associated with said user contribution icon and given in consideration for sharing by the content provider of the personal content data and a display control unit configured to control a display screen, said display screen configured to display the contribution icon and the personal content data simultaneously (see Figs.1, 3A & 3B,6, 10 and paragraphs , 0008, 0031-34. In fig.1 "Donor 12" represents a donor's computer terminal, the receiving unit to receive content data on a monitor in form of displaying web pages, see Figs.3A & 3B from a predetermined server, that is website "11" of a charitable organization. The web page, as displayed in Fig.3A, displays user contribution icons, " General Donation, Tribute Donation, Silver Level Sponsorship.... "including a contribution buttons, like " GIVE or ADD", which when pressed, indicates that a contribution is to be given, see Fig.6. Both Figs 3A and 3B show content data comprising different types of postcards that can be

Art Unit: 3625

downloaded for viewing and enabling the contributor to decide which one to choose for making the contribution. The contribution is given to the web site which is the content provider because it provides the content in the form of different types of post cards.

Note: The limitation, " to receive personal content data which were personally created by a content provider, to indicate that a contribution is to be given to the content provider of the personal content data associated with said user contribution icon and given in consideration for sharing by the content provider of the personal content data ", is an intended use and does not add to the structure of the device or to a manipulative step and therefore cannot be considered for patentability. The examiner would like to point out that the limitation, that is the type of data [personal content produced by a content provider] the claimed device in claim 1 receives is an intended use and therefore cannot be considered for patentability. The prior art structure, that is the apparatus in Miller is capable of receiving personal content data created by a content provider over a network and therefore it meets the currently amended claim1. In Miller, see paragraph 033 which suggests that a donor can make a contribution for a special project which could refer to a personal content data personally created by a content provider and received over a network at the website 11 and stored in database 14 from where can be retrieved by clicking the button "view", see Figs 3A, 3B and 10.

Miller's apparatus further suggests displaying both the personal content and the contribution icon, simultaneously, see Figs 3A, 3B and 10 wherein a donor can view the icon representative of the content and the contribution icon simultaneously and by clicking on "view" can see the description of the content.

a contribution acceptance unit configured to provide an indication of an acceptance of the contribution from a user and a contribution data creating unit configured to create contribution data that corresponds to a given amount of the contribution after the contribution button is selected on said content display screen (see Figs. 3A, 3B, 5, 8 and paragraphs 0033- 0034. System accepts a contribution of \$5, for example, from the donor after contribution button was pressed on screen, as shown in Fig.3A and after accepting the contribution amount the system selects and creates contribution data, that is a "Report" or ""Book" or " Postcards", etc corresponding to the contribution amount); and

a transmitting unit configured to transmit said contribution data created by said contribution data creating unit to a contribution managing device over said network (see at least Figs. 3A, 3B and 5 which disclose that if a donor selects a contribution data, such as "E-mail postcards" this is transmitted over a network by e-mail to the charitable web site "11" for making delivery of the selected "E-mail postcards" corresponding to the contribution amount to the donor).

Miller does not teach if the contributions are made by registered users then there would no subsequent request for information regarding how payment is going to be made. However, in the analogous field of making payments online for electronic commercial transactions, Hartman teaches the use of single-click step by registered shoppers while placing orders online and when they are ready with the order [a parallel to the event that when a donor is ready to contribute in Miller] such that the system does not have to make a subsequent request for information regarding how payment is

Art Unit: 3625

going to be made (see at least col.3, line 30-col.4, line 1. Purchasers with client subsystems having unique client identifiers correspond to registered users in the instant application and when these purchasers shop with those client systems they are not requested for payment information subsequent to the purchaser's selection of an item for placing an order, which is parallel to the event when a donor is ready to contribute in Miller online). In view of Hartman, it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Miller to incorporate the concept of single-click donation step that is when the donor is ready to donate he has to press the donation button without having to be requested subsequently for providing information as how payment is to be made. Doing so would help both the donor and the system to reduce the number of interactions between the donor and the server and also reduces the amount of sensitive information, such as credit card number, between the donor and the server, as explicitly taught in Hartman (see col.3, lines 30-40).

Regarding claim 3, Miller teaches that said contribution data creating unit is configured to create said contribution data equivalent to an amount which is directly entered in a contribution amount input area corresponding to said contribution button when the contribution button is selected (see paragraphs 0032-0034, 0039, Fig.6 which shows that the contribution data creating unit is configured to create a contribution data equivalent to an amount which is directly entered).

Regarding claim 4, Miller teaches that said contribution data creating unit is configured to change an amount directly entered in a contribution amount input area corresponding to said contribution button by the amount more than a fixed minimum amount, according to user's operations when the contribution button is selected, and to create said contribution data equivalent to the changed amount (see paragraphs 0032-0034, 0039, Fig.6 which shows that the contribution data creating unit is configured to create a contribution data equivalent to an amount which is directly entered and further if desired the entered amount can be changed).

Regarding claims 5, 7-8, and 13, 15-16, their limitations are closely parallel to the limitations of claims 1, 3-4 and are therefore analyzed and rejected based upon the same rationale.

Regarding claim 30, Miller teaches that said predetermined server comprises the contribution managing device (see Fig.1 wherein the predetermined server,"11" includes the contribution managing device as part of the charitable web site.).

Regarding claim 32, Miller/Hartman teaches as how a registered user donates contribution amount in dollars on a network but does not teach that contribution amount could be points instead of dollars. The type of contribution, that is if it is an amount in dollars or amount of points [accumulated bonus points, such as reward points accumulated in credit card transactions or frequent flier miles, etc. which enable the

Art Unit: 3625

user to either cash them or use them for buying services/products] does not affect the structure of the system being used because the same structure facilitates the contribution either in dollars or in points which are realized from the user's account. The type of contribution whether in dollars or in points does not affect the functionality of the system because irrespective of the type of amount in dollars or points the user would be able to indicate the indicia or number or amount in digits that he wants to contribute in dollars or points in the same way. Therefore, it would be obvious to one of an ordinary skilled in the art to adapt the system/method of Miller/Hartman as analyzed in claim 1 above to let the user contribute points instead of dollars if he wants that way.

5.2. Claims 2, 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller/Hartman in view of Ziarno (US Publication 2001/0001855 A1).

Regarding claim 2, Miller/Hartman shows that said contribution data creating unit creates contribution data after said contribution button is selected by entering a minimum amount or higher than the minimum amount, as analyzed for claim 1 above but does not teach displaying a contribution amount selection screen showing a plurality of amounts on said display means in response to the selection of said contribution button, and creates said contribution data corresponding to said amount selected on said contribution amount selection screen. However, in the same field of endeavor of creating contribution data online Ziarno teaches the missing limitation, that is displaying a contribution amount selection screen showing a plurality of amounts on

Art Unit: 3625

said display means in response to the selection of said contribution button, and creates said contribution data corresponding to said amount selected on said contribution amount selection screen (see at least paragraphs 0059-0060 which disclose displaying variants of the contribution amounts, such as \$5 or \$10 or \$100 or more to make it convenient for the givers to choose according to their means, that is affluent people can choose from higher denominations and less affluent can choose the lower denominations.). In view of Ziarno, it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to modify Miller/Hartman to incorporate the Ziarno's suggestions, that is displaying a contribution amount selection screen showing a plurality of amounts on said display means in response to the selection of said contribution button, and creates said contribution data corresponding to said amount selected on said contribution amount selection screen because it would make it convenient for the contribution givers to choose a particular denomination amount as per his economic capability, that is _affluent people can choose from higher denominations and less affluent can choose the lower denominations.

Regarding claims 6 and 14, their limitations are closely parallel to the limitations of claim 2 and are therefore analyzed and rejected based upon the same rationale.

5.3. Claims 24-25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller/Hartman in view of Ziarno and further in view of Guheen et al. (US Patent 6,473,794).

Regarding claim 24, Dougherty shows that said contribution data creating means creates contribution data equivalent to a given amount corresponding to said button and transmitting said contribution data to said content providing device, as analyzed for claim 1. Dougherty shows that the contribution data is sent to the information provider who could be the fund raiser for the candidate or for a charity event and such fund raisers are more than one (see col.5, lines 55-67). The fund raiser in Dougherty corresponds to the "user" as recited in the claim, that is the party who supplied the content for raising funds either for a presidential candidate as shown in Dougherty or it could be for a charity event [because it is well-known to raise funds for charity events, see Ziarno and Miller for evidence].

Dougherty does not explicitly show that the contribution data is added to the fundraiser's information before sending it to the fund-raiser. However, It would be obvious to one of an ordinary skilled in the art that the contribution data from various fund givers would be added to every fund raiser's information who is using the system to collect funds to consolidate the receipt of contribution data along with the information who contributed before sending it so that their contributions can be acknowledged and receipts sent.

Dougherty does not disclose adding a service charge for supplying said content to the user's information. However, it is well-known to one of an ordinary skilled in the art that an online service may charge a user for displaying content such as data/images for raising funds (see Guheen col.192, lines 3-17, "*Four different types of*

Art Unit: 3625

commercial transactions might commonly occur in a commercial online service. First, a user may be charged for the right to access all or parts of a useful publicly accessible online system. Second, the online service may pay the user for performing some type of action such as winning a contest or completing a marketing survey. Third, an online service may charge a content provider for placing certain information on the online service. For example, a content provider can be charged for placing an advertisement on the online service. Finally, a content provider can be paid by the online service for providing information that users may wish to access, can be can be provided on a for-fee basis. Conversely, an online service provider may wish to pay third party content providers for placing useful material on the online service. "). In view of the disclosure in Guheen, it would be obvious to one of an ordinary skilled in the art that in the disclosure of Daugherty the online service provider would charge the user/fundraiser and add this information, that is the billing information to the user's account for letting him display the content to the public at large to receive contribution data/funds for election campaign.

Regarding claim 25, its limitations are closely parallel to the limitations of claim 24 and is therefore analyzed and rejected based upon the same rationale.

Regarding claim 33, its limitations are already covered in claims 1 and 24 and is therefore analyzed and rejected based upon the same rationale.

5.4. Claim 31 is rejected under 35 U.S.C. 103(a) as being obvious over Miller/Hartman in view of Official Notice

Regarding claim 31, Miller/Hartman teaches a contribution processing device where the contribution amount is indicated in US dollars. Miller does not teach that the

Art Unit: 3625

contribution amount could also be in electronic money. The examiner takes Official Notice of the well-known fact of using electronic money for small electronic commercial transactions and therefore in view of this Official Notice it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to use electronic money in Miller for donating small amounts when conducting electronic commercial transactions in electronic money. Use of electronic money will obviate the use of credit cards when making small denomination payments and that will help to reduce interactions with the donor in receiving payment information and also reduces transmission of sensitive information, such as credit card number via network.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3625

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
9/30/2007